

REMARKS

Claims 1-8 are pending. By this Amendment, claim 1 is amended to clarify the features recited. Support for the amendments can be found in Applicant's specification, for example, at paragraph [0036]. No new matter is added. Reconsideration of the application based on the above amendments and following remarks is respectfully requested.

Claims 1-8 are rejected under 35 U.S.C. §102(b) over Saito (JP-A-2002-352837). The rejection is respectfully traversed.

Saito fails to disclose among other features, a control section, comprising a computer configured to control...the control section estimates a gas permeation quantity of at least one of the fuel gas and the oxidizing gas between the anode and the cathode after the power generation performed by the fuel cell is stopped based on the detected voltage; and wherein the control section corrects a supply quantity of at least one of the fuel gas and the oxidizing gas each corresponding to the load in accordance with the estimated gas permeation quantity, which is to be supplied by the gas supply unit upon a subsequent start of power generation, as recited in claim 1.

Claim 1 positively recites a first detector and second detector, and that control is executed by a control section comprising a computer based on the detected results as explained below. Saito does not disclose a control section comprising a computer that controls based on the first and second detectors, as recited in claim 1.

Furthermore, in rejecting claim 1, the Office Action effectively admits that that Saito fails to disclose the above-quoted features. In order to cure this deficiency of Saito, the Office Action cites *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997), and alleges that the above-quoted features are mere functional limitations and recite only a manner of use. This assertion is unreasonable for at least the following reasons.

In *Schreiber*, the Federal Circuit agreed that a conical container top for dispensing

popped popcorn was anticipated by a conical spout used primarily to dispense oil from a can because the oil conical spout inherently performed the function recited in the Applicant's claims. *Schreiber* recited a dispensing top for dispensing popped popcorn in a specific manner in the preamble of the claim. The Federal Court held that this recitation was a mere intended use.

The holding in *Schreiber* indicates that, if a claim recites only an intended use of a prior art device, the claim should be rejected as anticipated by the prior art device.

Claim 1 is distinguished from the facts in *Schreiber* because, claim 1 positively recites structure of "a first detector...a second detector...a control section, comprising a computer configured to control..." and affirmatively recites the structure of the control section in the body of the claim. That is, unlike *Schreiber*, which recited an intended use (popped popcorn dispenser) of a conical spout disclosed by the reference (oil conical spout), Applicant's claim 1 recites a structure that is not disclosed by Saito. The Office Action effectively admits that Saito fails to disclose this structure in both the rejection of claim 1, and in the Response to Arguments section. See Office Action page 3, lines 2-4 and page 4, lines 8-10 and line 20-page 5, line 2.

Further, the structure of the detectors and the control section, comprising a computer is recited in the body of claim 1, not a mere intended use recited in the preamble. Claim 1 positively recites a first detector...second detector, a control section comprising a computer..., and how the control is carried out based on detected values. That is, Applicant's claim more than a mere intended use of the structure of Saito. As acknowledged by the Office Action, Saito discloses a completely different controller than that recited in claim 1. For at least the foregoing reasons, Office Action misapplies *Schreiber* and the structure recited in the pending claims is not disclosed in Saito. That is, Saito fails to disclose a control section, comprising a computer...as recited in claim 1.

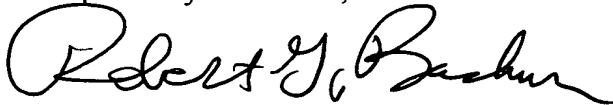
Lastly, the Office Action's allegation that the controller of Saito inherently is capable of performing the features recited in Applicant's claims is without merit. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See* MPEP §2112. In rejecting Applicant's claims, the Office Action acknowledges that Saito does not disclose a controller, as recited in Applicant's claims. That is Saito does not inherently include a controller capable of performing the features recited in claim 1.

Thus, Saito could not reasonably be interpreted to disclose the combination of all of the features recited in claim 1. Accordingly, Saito also fails to disclose the features recited by claims 2-8 for at least the dependence of these claims on claim 1 and for the separately patentable features that these claims recite. Withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-8 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Robert G. Bachner
Registration No. 60,122

JAO:RGB/kjb

Date: September 16, 2010

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE
AUTHORIZATION

Please grant any extension
necessary for entry of this filing;
Charge any fee due to our
Deposit Account No. 15-0461